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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,586	07/05/2000	Larry A Spino	32234-164775	5218

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BP-AMERICA INC.
BP CORPORATION NORTH AMERICA INC.
200 EAST RANDOLPH DRIVE
MAIL CODE 2207A
CHICAGO, IL 60601-7125

EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/610,586		SPINO ET AL.	
	Examiner		Art Unit	
	William K Cheung		1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Information Disclosure Statement

1. In view of PTO-1449 Form submitted with amendment (Paper No. 9) filed December 2, 2002, the information disclosure statement issued has been resolved.
2. In view of amendment (Paper No. 9) filed December 2, 2002, claims 10-11 have been cancelled. Claims 1-9 are pending.
3. In view of amendment (Paper No. 9) filed December 2, 2002, the objection to specification is withdrawn. The support for the amendment could be found on page 3, second paragraph of Paper No. 9.
4. In view of amendment (Paper No. 9) filed December 2, 2002, the rejection of claims 1-11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 3 stands rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 (line 1-3), the recitation "the propylene polymer contains from 100 mg to 500 mg of inorganic residue per kg of propylene polymer" set forth a propylene polymer which requires the claimed propylene polymer to have an inorganic residue of 100-500 mg per kg of propylene polymer. However, in view of the disclosure to Masino (col. 12, line 15-40), there is a high degree of error in determining the amount of inorganic substances such as titanium in a propylene polymer sample. Therefore, since applicants' specification does disclose the proper method for determining the amount of inorganic residue for carrying out the claim 3 invention, the examiner has reasons to believe that one of ordinary skill would have a difficult time to make/use of the claimed invention of claim 3 because one of ordinary skill in the art clearly would not know the proper techniques for determining the amount of inorganic residue per kg of propylene polymer in order to make/use of the invention of claim 3.

Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive. Applicants argue that the high degree of experimental error is related to the observed high productivity, and not the titanium content. However, applicants fail to recognize that experimental error in high productivity is linked to the titanium content. Therefore, the examiner has a reasonable basis to believe that both high productivity and the titanium content are questionably in error.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-2, 5-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McCullough et al. (WO 00/12605) in view of Ushioda et al. (US 6,410,662 B1) for the reasons adequately set forth from paragraph 8 of non-final office action (Paper No. 5).

Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive.

Applicants argue that there is no motivation to combine the recited references. However, applicants fail to recognize that the motivation was clearly quoted in non-final office action (Paper No. 5, paragraph 8). The examiner clearly indicates that the difference between the disclosure to McCullough et al. and the present invention is that McCullough et al. are silent on using a clarifying agent in the disclosed composition.

Further, the examiner clearly indicates that Ushioda et al. (col. 15, line 7-18) disclose the benefits of using nucleating agents, benzylidene sorbitol (col. 16, line 5-31) and aluminum hydroxy-bis[2,2'-methylene-bis(4,6-di-tert-butylphenyl)phosphate] as a nucleating agent (col. 15, line 50) to improve the transparency (clarity) of polypropylene. Therefore, motivated by the expectation of success of improving the rigidity, heat-resisting property and transparency of polypropylene (col. 15, line 9-12), it would have been obvious to one of ordinary skill in the art to use the teachings of Ushioda et al. which teach using a nucleating agent such as benzylidene sorbitol and aluminum

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hydroxy-bis[2,2'-methylene-bis(4,6-di-tert-butylphenyl)phosphate] compounds to improve transparency into the disclosure to McCullough et al. to obtain the invention of claims 1-2, 5-8.

In response to applicants' argument that "antioxidants which may be most useful in the compositions of the present invention include primary antioxidants of phenolic type" of McCullough et al., the examiner rechecks the prior art to McCullough et al. (page 7, paragraph 2) and notes that McCullough et al. (page 7, paragraph 2) do not quote "antioxidants which may be most useful in the compositions of the present invention include primary antioxidants of phenolic type". Instead, McCullough et al. merely suggest that the invention may also contain additives generally termed stabilizers, and antioxidants.

Anyway, applicants must recognize that McCullough et al. (page 11, last paragraph; page 12, Table 1) in examples 4-6 disclose polypropylene compositions containing no phenolic antioxidant and satisfying the claim requirement of "free or essentially free of phenolic antioxidant" of claim 1. Although McCullough et al. suggest that the composition of McCullough et al. may contain stabilizers or antioxidants, applicants must also recognize that such disclosure does not teach away from the explicit teachings in McCullough et al. (page 12, Table 1, examples 4-6).

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9. Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over McCullough et al. (WO 00/12605) in view of Ushioda et al. (US 6,410,662 B1) and further in view of Masino (US 5,182,341) for the reasons adequately set forth from paragraph 9 of non-final office action (Paper No. 5) and for the reasons adequately set forth from paragraph 8 of instant office action.

Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive.

Regarding applicants' argument that the claimed invention does not include a recitation of a high melt flow polypropylene with a specific melt flow as in claim 1 of McCullough, however, applicants must recognize that the disclosed high melt flow polypropylene is still a polypropylene which is generically claimed in applicants' claim 1.

Regarding applicants' objection to the statement made by the examiner "does not indicate the criticality of the claimed inorganic residue range, the rejection set forth is proper", applicants fail to consider the sentence before such recitation. Applicants please note office action (Page 9, 1st paragraph) contain a quotation "in view of the disclosure to McCullough et al. and Masino, the propylene polymer of McCullough et al. generically include the propylene polymer of applicants' claim 3. Since applicants' specification does not indicate the criticality of the claimed inorganic residue range, the rejection set forth is proper. To obtain a valid invention, applicants must demonstrate

the criticality of the instant invention with comparative experimental data to show the criticality of the claimed 100 mg to 500 mg range of inorganic residue.”

10. Claims 1, 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 6,238,615 B1) for the reasons adequately set forth from paragraph 10 of non-final office action (Paper No. 5).

Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive.

Applicants argue that the motivation set forth by the examiner for the rejection of claims 1, 4 is improper. However, the examiner disagrees because Kobayashi et al. (col. 1, line 5-10) clearly suggest a molding composition capable of giving molded articles having high rigidity and high surface gloss, it would have been obvious to one of ordinary skill in the art to use all the molding composition teachings in Kobayashi et al. and assemble them into a single embodiment to obtain the invention of claim 1, 4.

Further, applicants must also recognize that although Kobayashi et al. (col. 11, line 67) disclose that the molding composition may contain other additives such as a stabilizer, Kobayashi et al. do not suggest one of ordinary skill in the art must use a stabilizer, especially pertaining to a phenolic antioxidant. Therefore, it would have been obvious to one of ordinary skill in the art to recognize that a phenolic antioxidant is not a

critical component in the disclosed molding composition. Although Kobayashi et al. (col. 14, line 53-54) in example 1 disclose using Irganox 1010 which is a phenolic based antioxidant, in re Nehrenberg 126 USPQ 383, applicants must recognize that a reference used in a rejection is not restricted to its preferred embodiment. As long as the broad teachings of Kobayashi et al. do not discourage one of ordinary skill in the art to use a phenolic- based antioxidant, the rejection set forth is proper.

11. Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 6,238,615 B1) in view of Ushioda et al. (US 6,410,662 B1) for the reasons adequately set forth from paragraph 10 of non-final office action (Paper No. 5) and for the reasons adequately set forth from paragraph 10 of instant office action.

Applicant's arguments filed December 2, 2002 have been fully considered but they are not persuasive.

Applicants argue that if the rejection of claims 1 and 4 (rejection #10) is overcome, the rejection of claim 9 should be overcome. However, since the rejection of claims 1 and 4 is not overcome as indicated in paragraph 10 of instant office action, claim 9 stands rejected.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5885 for regular communications and (703) 305-5885 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



William K. Cheung
January 7, 2003


PETER D. MULCAHY
PRIMARY EXAMINER